

REMARKS/ARGUMENTS

Claims 17-20, 22, 24, 26, 29-33, 39, 43 and 45 remain in the present application. Claims 17-20, 24, 31, 32, 33, 39 and 43 are currently amended to:

- Indicate that the deinking composition is solid at room temperature. Support for this limitation is contained on page 7, lines 15 et seq. of the specification.
- Limit the size of the R group and the numbers of ethoxy and propylene oxide moieties. Support for the added limitations are contained in the specification on page 5, lines 1 et seq., and page 10.

Applicant reserves the right to file one or more divisional/continuation applications directed to subject matter canceled by this amendment.

Applicants have previously shown that none of the art of record in this case discloses the use of the deinking composition of the present invention (with a large R group, a high degree of ethoxylation, and a low degree of propylene oxidelation) that is used for wash deinking (in contrast to flotation deinking). The relative size of these three constituents in one surfactant is unique when used in wash deinking processes. In his Advisory Action, the Examiner notes that the language "consisting essentially of" would not preclude the inclusion of well known deinking surfactants. However, the issue presented by these claims is whether the prior art teaches the use of this surfactant, with its balance of R/EO/PO components, in a wash deinking system. The prior art of record does not teach this use, and does not anticipate or render obvious the pending claims.

Nevertheless, in a spirit of cooperation and to have this application more promptly allowed, Applicants have amended the claims to (1) clarify that the deinking composition is solid at room temperature, and (2) narrow the size of the R group and the numbers of ethoxy and propylene oxide moieties in the surfactant. The ranges of variables that define the claimed deinking composition is now even narrower in scope than previously claimed, and avoid the prior art even further.

The use of a solid deinking composition also is also significant. This limitation is nowhere taught by the cited prior art for these types of compositions. In addition, the fact that

this composition has achieved commercial success, despite the difficulty of handling a solid composition, is unexpected and proves the nonobviousness of the claimed invention.

Applicants wish to note for the record the Examiner's cooperation and candor in this matter. The Examiner is rightly concerned that someone could be commercially and publicly using surfactants of the type claimed herein in wash-based deinking, and that the Applicants could put a halt to such activity if a patent were improperly granted. In response, however, Applicants wish to point out the following salient facts:

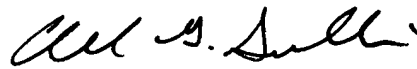
- Applicants are not aware of any mills in the United States that are using surfactants of the type claimed herein in wash deinking processes. If they are using these surfactants in wash deinking processes, they are doing so secretly in a non-public manner.
- They have conducted extensive searches of the prior art to determine whether any such art actually teaches the claimed method, and have confirmed that the prior art does not contain such a teaching. The results of Applicants' searches are attached hereto.
- They have conducted extensive comparative testing with actual prior art commercial products, and reported those results in the examples of this application. In particular, Applicants have compared the claimed composition with 16 prior art compositions, including a number of commercial deinking agents. None of the prior art compositions are covered by the pending claims.

Lastly, Applicants note the unexpected superior results achieved by their claimed compositions over the prior art. As the examples show, the residual ink content (a/k/a "ERIC") in pulp treated by the compositions of the present invention is remarkably lower than the residual ink content in pulp treated by prior art compositions. None of the prior art compositions achieved ERIC values below 300 ppm, whereas the compositions of the present invention uniformly achieved ERIC values in the 200 ppm range. These results were surprising and unexpected and further prove the nonobviousness of the claimed invention.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests the reconsideration of this application and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 11-0980.

Respectfully submitted,



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